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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,291	11/30/1999	LIEPING CHEN	07039-187001	8838

7590 07/17/2002

FISH & RICHARDSON PC  
60 SOUTH SIXTH STREET SUITE 3300  
MINNEAPOLIS, MN 55402

EXAMINER

SOUAYA, JEHANNE E

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 07/17/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No.  
**09/451,291**Applicant(s)  
**Chen**Examiner  
**Jehanne Souaya**Art Unit  
**1634**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 26, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Apr 15, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 4 and 5

Claim(s) objected to: none

Claim(s) rejected: 1, 11-13, 36, 37, and 45-51

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☐ Other:

## ATTACHMENT

The amendment will not be entered because the recitation of “segment” raises new issues and would require new grounds for rejection under 35 USC 112 first and second paragraph. The specification teaches that the B7-H1 nucleic acid molecules of the invention can be cDNA, genomic DNA, synthetic DNA or RNA and that segments of these molecules are also considered within the scope of the invention and can be produced by PCR. Therefore, the recitation of “segment” in proposed claim 52 encompasses pieces of genomic DNA which have not been taught or described by the specification.

Further, applicant's should note that if the amendment were to be entered, claims 45-51 (in the proposed amendment filed 6/26/2002) do not overcome the rejections made under 35 USC 112/1st paragraph made in the previous office actions. Were the amendment to be entered, only claims 1, 4-5, 11-13, 36 and 37 would be allowable over the prior art. The remaining claims would still be rejected under the outstanding enablement and written description rejections due to the language of “functional fragment” for the reasons made in previous office actions. With regard to applicant's understanding of the examiner's position regarding the pending claims, the previous rejections were not made solely based on the recitation of conservative substitutions, therefore, while the deletion of this subject matter addresses some of the examiner's points, the proposed amendment would not overcome the previous rejections of claims 45-51 (see final rejection mailed 12/13/2001 which indicates that claims 45-51 are rejected under 35 USC 112/1st paragraph/enablement, especially p. 3, lines 4 and 5; p. 6-7, and p. 8, ).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Jehanne Souaya*

Jehanne Souaya  
Patent examiner  
Art Unit 1634

7/12/2002

*Lisa B. Arthur*

LISA B. ARTHUR  
PRIMARY EXAMINER  
GROUP 1800-1600